



Declaration of Richard Henry
Appl. Ser. No. 09/869,700

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OFFICE OF PETITIONS

PATENT
Attorney Docket No.: 8830-17 (formerly 03000018AA)
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of Richard Henry :
Serial No.: 09/869,700 : Group Art Unit: 1614
Filed: September 4, 2001 : Examiner: James H. Reamer
For: TOPICAL ANESTHESIA OF :
THE URINARY BLADDER : Confirmation No.: 8542

DECLARATION OF RICHARD HENRY

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, Richard Henry, declare as follows:

1. I am the inventor of the above-identified patent application. This declaration is submitted in support of my Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

2. My patent application is the subject of an exclusive license in favor of Medpharma, plc, Charlbury, United Kingdom ("Medpharma"), pursuant to a License Agreement dated December 24, 2000 (Exhibit 1). Sections 4 "Payments and Royalties" and 5 "Reports" contain sensitive commercial information, and have been redacted from the License Agreement copy

**CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

BY

6/10/05 *Sharon R. Smith*

DATE:

comprising Exhibit 1. The license in favor of Medpharma extends to the present application by virtue of the listing of PCT/CA00/0003 in "Exhibit A" to the License Agreement. The present application is the US national stage of PCT/CA00/0003, which claims the priority of Application Serial No. 60/114,857.

3. Pursuant to paragraph 6.2 of the License Agreement, Medpharma is responsible for payment of all costs pertaining to prosecution of the subject patent application. The final sentence of paragraph 6.2 provides for the direct billing of those legal costs to Medpharma by patent counsel. Paragraph 6.3 provides that Medpharma and I, as licensee and owner, shall cooperate in the prosecution of the application. The final sentence of the same paragraph provides that each party shall provide prompt notice to the other regarding all matters which may affect the prosecution and maintenance of the application. Section 6.4 provides that Medpharma must give me sixty days advance notice before ceasing financial support for prosecution of the application.

4. While the License Agreement provides that I, as owner, bear responsibility for patent prosecution, I elected to permit Medpharma to direct worldwide prosecution of all licensed patent applications through patent attorneys of Medpharma's choosing, the firm of Murgitroyd & Company, Glasgow, United Kingdom ("Murgitroyd"). I did so with the understanding that, in keeping with paragraphs 6.3 and 6.4, I would be provided with advance notice of any proposed action by Medpharma adverse to the continued maintenance of any patent property in the licensed patent estate.

5. I received notice of a May 7, 2002 final Office Action under cover of a letter dated June 6, 2002 from Murgitroyd's Beverly Ouzman to Medpharma's Tim Griffiths (Exhibit 2). I was also copied on Ms. Ouzman's subsequent July 3, 2002 (Exhibit 3) and July 22, 2005 (Exhibit 4) letters on the same subject. Portions of the foregoing correspondence touching on the substance of the office action have been redacted.

6. After the July 22 letter Ouzman letter, I received no further communications from either Murgitroyd or Medpharma regarding the subject patent application until May 3, 2005. At that time I learned for the first time that Medpharma instructed Murgitroyd to allow the application to become abandoned in 2002, by withholding a response to the May 7, 2002 final

Office Action. At no time prior to May 3, 2005 did I have any knowledge that the application had been abandoned. At no time did I intend for the application to become abandoned. Medpharma's action in allowing the application to lapse was made without consulting me, in contravention of License Agreement paragraph 6.3, mandating prompt notice of all matters affecting the prosecution and maintenance of the application. Medpharma's action also contravened License Agreement paragraph 6.4, mandating 60 day advance notice by Medpharma before cessation of financial support for the application.

7. Accordingly, the entire delay from the date for the required reply to the May 7, 2002, final Office Action to the filing of the accompanying Petition for Revival was unintentional.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

2nd June 2005
(date)


RICHARD HENRY